

REMARKS

This application pertains to a novel antistatic pressure-sensitive adhesive tape.

Claims 1-15 are pending.

The Adhesive tape comprises a carrier layer, a first pressure-sensitive adhesive layer, and a first electrically conductive primer layer directly between the carrier layer and the at least one pressure-sensitive adhesive layer. The electrically conductive primer layer provides both an antistatic function and a primer function. This electrically conductive primer layer effects electrical conductance as well as good adherence of the first pressure sensitive adhesive to the carrier.

The first pressure-sensitive adhesive layer is free of electrically conductive materials.

Claims 1-6 and 8-15 stand rejected under 35 U.S.C. 112, first paragraph, because the Examiner does not see where the specification provides support for the exclusion of the electrically conductive particles (now materials) from the PSA layer.

In the Office Action, the Examiner pointed out, however, that "If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims".

Page 7. lines 21-26 of the specification, referring to the PSA portion of the adhesive tape, teaches that:

In addition it is possible optionally to add plasticizers, further fillers (such as, for example, fibers, carbon black, zinc oxide, chalk, solid or hollow glass beads, microbeads of other materials, silica, silicates), nucleators, electrically conductive materials, such as conjugated polymers, doped conjugated polymers, metal pigments, metal particles, metal salts, graphite, etc., expandants, compounding agents and/or aging inhibitors, in the form for example of primary and secondary antioxidants or in the form of light stabilizers.

Clearly, the presence of electrical conductive materials in the PSA is "optional". The use of the expression "optionally" has been recognized as acceptable alternative language (See MPEP §2173.05(h)(III)).

The foregoing language, in teaching that the presence of electrically conductive material is optional, constitutes a teaching of the alternatives that the electrically conductive materials may be present, or they may not be present. That is what optional means. Therefore, in accordance with the foregoing section of the MPEP, and the Examiner's comment, the alternative element i.e., the electrically conductive materials may be explicitly excluded in the claims.

Applicants' claims therefore do not violate the first paragraph of 35 U.S.C. 112, and the rejection of claims 1-6 and 8-15 under 35 U.S.C. 112, first paragraph, should now be withdrawn.

Claims 1 and 5 stand rejected under 35 U.S.C. 102(b) as anticipated by Wallner (US 3,146,882).

Wallner concerns an antistatic primer which is provided by blending "a normal insulating primer coating composition" with a minor proportion by weight of a suitable antistatic polymer, such as a hydrophylic film-forming ionogenic polymer which provides ionic conductivity in the presence of moisture.

Applicants' claims, by contrast, require **electrically conductive** materials in the primer layer, not ionogenic polymers. Ionogenic polymers are polymers which form ions; these are different than electrically conductive materials

Further, Applicants' electrically conductive particles do not need moisture to function, whereas Wallner's ionic conductive materials do.

Accordingly, Willner's antistatic primers, which rely on ionogenic polymers, are different than Applicants electrically conductive primers which comprise electrically conductive materials.

Claims 1 and 5 cannot therefore be seen as anticipated by the Wallner reference, and the rejection of claims 1 and 5 under 35 U.S.C. 102(b) as anticipated by Wallner (US 3,146,882) should therefore now be withdrawn.

Claim 6 stands rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wallner (U.S. 3,146,882) as applied to claim 1.

The Examiner acknowledges that Wallner is silent as to shrinkback, but finds it reasonable to presume that said feature of shrinkback is present in the adhesive tape of Wallner. There is, of course, no basis for such a presumption. More important, however, is the fact that claim 6 depends from claim 1 and the differences between claim 1 and the teachings of the Wallner reference have been discussed above. The Examiner has not pointed to anything in the Wallner reference that would overcome the differences discussed above, or that would even support his presumption of shrinkback. Accordingly, claim 6 cannot be seen as anticipated by or obvious over the Wallner reference, and the rejection of claim 6 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wallner (U.S. 3,146,882) as applied to claim 1, should now be withdrawn.

Claims 2-4 and 11-13 stand rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 and further in view of Akhter (US 5,958,537).

The Examiner acknowledges that Wallner is silent as to teaching claim 2-4 and 11-13, but contends that Akhter discloses a static dispersing label comprising a backing film, at least one pressure sensitive adhesive layer and a primer layer containing

electrically conductive particles that is between the carrier layer and the pressure-sensitive layer.

The Examiner will note, however, that the Akhter reference relies on **both** conductive particles within the primer layer **and conductive particles in the PSA layer**, which extend from a first surface of the PSA layer to a second surface of the PSA layer; the first surface of the PSA layer being in intimate and binding contact with the second surface of the primer layer.

Those skilled in the art would therefore read Akhter as requiring conductive particles in both the adhesive layer and the primer layer, and would not be led to add conductive particles to the primer layer without also adding them to the PSA layer.

In view of this, Applicants' invention, which requires conductive particles in only the primer layer and which does not have any conductive particles in the PSA layer, is truly surprising. Those skilled in the art reading Akhter would find it truly surprising that Applicants adhesive tape, which has electrically conductive particles only in the primer layer, could pass the antistatic test (see Table 2, page 24, of Applicants' specification).

Applicants' claims cannot therefore be seen as obvious over any combination of Wallner and Akhter, and the rejection of claims 2-4 and 11-13 under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 and further in view of Akhter (US 5,958,537) should now be withdrawn.

Claims 8 and 9 stand rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 and further in view of Kitamura et al (US 5,759,679).

Claims 8 and 9 depend from claim 1, and therefore incorporate all the limitations of claim 1.

The Examiner acknowledges that Wallner is silent as to teaching the structure of the PSA tape as required by claims 8 and 9, but relies on Kitamura et al for a teaching that a PSA layer can be applied on one or both sides of a foamed substrate (carrier), and that a primer layer can be applied to the surface of a carrier layer to improve the anchoring property of the PSA layer.

The differences between Applicants' antistatic pressure sensitive adhesive tape and anything that can be found in the Wallner reference are discussed above. The additional layers that the Examiner finds in the Kitamura reference do not in any way overcome any of these differences. More specifically, Kitamura's teaching that a PSA layer can be applied on one or both sides of the foamed substrate (carrier), and Kitamura's teaching that a primer layer can be applied to the surface of the carrier layer, do not compensate for the failure of the Wallner reference to teach or suggest the use of electrically conductive materials in the primer layer.

Accordingly, no combination of Wallner and Kitamura could possibly lead to the invention defined by Applicants' claims, and the rejection of claims 8 and 9 under 35

U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 and further in view of Kitamura et al (US 5,759,679) should now be withdrawn.

Claim 10 stands rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1, and further in view of Luhmann et al (US 6,395,389 B1).

The Examiner acknowledges that Wallner is silent with respect to disclosing the PSA tape in the form of punched product, but relies on Luhmann for a teaching of punched adhesive strip sections covered on one side with a release laminate. The Examiner then concludes that it would be obvious to produce "the" tape in the form of a punched product because doing so involves routine skill in the art.

No combination of Wallner and Luhmann could ever lead to the pressure sensitive adhesive tape of Applicants' claim 1 in the form of a punched product, as recited in Applicants' claim 10, because the antistatic pressure sensitive adhesive tape of Applicants' claim 1 is different than and non-obvious over the adhesive tape of Wallner, as discussed above. If the adhesive tape of the Wallner reference were provided in the form of a punched product, such a punched product would be different than the pressure-sensitive adhesive tape of Applicants' claim 1 in the form of a punched product. The Adhesive tape of Applicants' claim 1 has electrically conductive materials in the primer layer, but not in the PSA layer; whereas the adhesive tape of the Wallner reference has a primer layer which comprises an antistatic polymer, such as a

hydrophilic film-forming ionogenic polymer which provides ionic conductivity in the presence of moisture.

Walner's adhesive tape, even if presented in the form of a punched product, would therefore be completely different than the punched product of Applicants claim 10 and the rejection of claim 10 under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1, and further in view of Luhmann et al (US 6,395,389 B1) should therefore now be withdrawn.

Claim 14 stands rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882 as applied to claim 1 and further in view of Craig et al (US 6,299,799 B1). The Examiner acknowledges that Wallner is silent with respect to electrically conductive polymers being 3, 4 polyethylenedioxythiophene, and relies on Craig for a teaching of creamer compositions that are capable of being cured to form antistatic, abrasion resistant creamers, and 3, 4 polyethylenedioxythiophene as electrically conductive polymers. The Examiner then concludes that it would be obvious to use 3, 4 polyethylenedioxythiophene in Wallner.

The Wallner reference requires antistatic agents which are exemplified by ionogenic polymers, such as ionizable organic polymer salts (col. 3, lines 29 and 57-59). These are not electrically conductive polymers, and there is no reason to substitute electrically conductive polymers, such as 3, 4 polyethylenedioxythiophene, for Wallner's ionizable organic polymer salts. No person reading Wallner and Craig would ever be led to use Craig's 3, 4 polyethylenedioxythiophene in Wallner's pressure sensitive

adhesive tape because Wallner's invention involves ionogenic polymers, not electrically conductive polymers. The use of 3, 4 polyethylenedioxythiophene would change the fundamental character of Wallner's primer, and would therefore be contrary to Wallner's teachings.

The rejection of claim 14 under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882 as applied to claim 1 and further in view of Craig et al (US 6,299,799 B1) should therefore now be withdrawn.

Claim 15 stands rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 and further in view of De Jonge et al (US 6,284,837). The Examiner contends that it would be obvious to use the polymethacrylate PSA of De Jonge as the PSA in Wallner's invention. Using polymethacrylate as the PSA in the Wallner adhesive tape will not overcome any of the differences pointed out above between Applicants' invention and the adhesive tape disclosed by Wallner, and will not bring the disclosure of the Wallner reference any closer to the antistatic pressure sensitive adhesive tape defined by Applicants' claim 15 (which depends from, and incorporates the limitations of, claims 5 and 1).

The rejection of claim 15 under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 and further in view of De Jonge et al (US 6,284,837) should therefore now be withdrawn.

In view of the present amendments and remarks it is believed that claims 1-15

are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicant requests that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No. 14-1263.

Respectfully submitted,
NORRIS, McLAUGHLIN & MARCUS

By /William C. Gerstenzang/
William C. Gerstenzang
Reg. No. 27,552

WCG/tmcc

875 Third Avenue- 18th Floor
New York, New York 10022
(212) 808-0700